

III. REMARKS

This Request for Continued Examination has been made in response to the issues and concerns raised in the Office Action of January 10, 2008. Assignee newly cancels claims 4-7 and 53-61 and newly adds claims 65-72. Since there are a greater number of cancelled claims as compared to the newly added claims and there are no independent claims in excess of 3, it is believed that no additional fees are required. Claims 1-3, 8, 31, 39-52, 62-72 are pending.

In view of the Examiner's previous restriction requirement and canceled claims, the Assignee asserts the right to present claims 4-7, 9-30, 32-38, and 53-61 in a subsequent continuation application, if desired. Assignee notes that claim status indications of "withdrawn" in parentheses indicate that the referenced claim is being withdrawn without prejudice in response to an earlier restriction requirement.

The action states that the reference CN 100998524A was not considered because it was in a language other than English. It is respectfully noted that the Assignee filed an explanation of relevance of this non-English language document on October 25, 2007 in accordance with 37 C.F.R. §1.98(a)(3). Accordingly, Assignee respectfully requests reconsideration of this reference.

35 U.S.C. § 112 Concerns

Assignee has amended independent claim 1 to include examples of various sheath fluids which may be used in the present embodiment and as supported by the application disclosure. The action expressed enablement concerns to the claims stating that, "... the claims still encompass embodiments that do not function because not all fluid sheath compositions will function for a given species." Assignee respectfully disagrees.

The action wrongfully assumes from the Seidel reference (WO99/33956) that there are necessary sperm species specific sheath fluids to practice the pending claims. The Seidel reference merely discusses that certain sheath fluids *may help* to minimize the stresses on sperm

cells. For example, the Seidel reference may discuss that citrate may be important with bovine sperm and a hepes buffer may be important for equine sperm. However, the Seidel reference *never discloses that other fluid sheaths do not work*, for example, the reference never discloses that hepes does not work with bovine sperm or perhaps even that citrate does not work with equine sperm. In another example, the Seidel reference states that a 2.9% sodium citrate composition may not perform as well with equine sperm. (*see* page 14 of the Seidel reference) Since the Seidel reference gives no data or explanation of what performance is based on, it is respectfully asserted that the statement “does not perform as well” does not mean that it does not work at all and that it is non-functional. As further referenced in the Seidel reference, a hepes buffered medium was developed for bovine applications. Thus, a hepes medium *can be* used – and *will* function – with bovine sperm. While this reference may suggest that enhancements may be made when using certain selected fluid sheaths, it does not teach or suggest that “not all fluid sheath composition will function for a given species” as stated in the action. As such, the state of the prior art does **not** teach that all fluid sheath compositions will **not** function for a given species.

Generally, it is understood to one skilled in the art that any sheath fluid can be used from species to species without major consequences. Therefore, the pending claims are enabled without having to specify a particular sheath fluid with a particular species. Accordingly, one reasonably skilled in the art could make or use the invention from the disclosures in this application coupled with information known in the art without undue experimentation.

35 U.S.C. § 102 Concerns

Claim 1 has been amended to state, *inter alia*, “altering flow characteristics of said fluid stream to adjust fluid stream pressure between at least two different fluid stream pressures” Accordingly, the Rath, Seidel, and Beyhan references do not teach or suggest the altering of pressures as clarified in independent claim 1. It is believed that the anticipation concerns to independent claim 1 and its dependent claims are moot.

Assignee has newly added claims 65-72. Independent claim 65 is similar to claim 1 with the removal of the sheath fluid examples, the removal of “about 40 psi when viability is selected” and the removal of “about” associated with the viability and motility pressures. Independent claim 65 and its dependencies are enabled for the above stated reasons. Further, the newly added claims are believed to be novel and non-obvious over the prior art.

Additional Information

The amendments submitted herein should be understood to be made as a practicality only, and should not to be construed as creating any situation of file wrapper estoppel or the like as all rights are expressly reserved and may be pursued in this or other applications, such as divisionals, continuations, or continuations-in-part if desired. Relatedly, it should be understood that the amendments made herein are made for tangential issues of clarity and as a matter of the Office’s convenience or expedience only. The amendments should not be interpreted as an action that in any way surrenders a particular equivalency, surrenders any right to patent coverage, or otherwise limits any rights which the Assignee may now or hereafter assert. It should be understood that, unless and to the extent deemed broadened by this amendment, and even as amended, the Assignee expressly reserves all rights, including but not limited to: all rights to maintain the scope of literal coverage with respect to any element as may have existed under the language previously presented, all rights to maintain the scope of equivalency coverage as may have existed under the language previously presented, and all rights to re-present the prior language at any time in this or any subsequent application. To the extent currently foreseeable, no change or reduction in direct or equivalency coverage is believed to exist, and no change or reduction in direct or equivalency coverage is intended through the presentation of this amendment.

Further, the office and any third persons interested in potential scope of this or subsequent applications should understand that broader claims may be presented at a later date in this or a continuation in spite of any preliminary amendments, other amendments, claim language, or arguments presented, thus there is not intention to disclaim or surrender any potential subject matter. It should be understood that such broader claims may require that any

relevant prior art that may have been considered may need to be re-visited since it is possible that to the extent any amendments, claim language, or arguments presented in this application are considered as made to avoid such prior art, such reasons may be eliminated by later presented claims or the like. Both the examiner and any person otherwise interested in existing or later coverage or considering the possibility of an indication of disclaimer or surrender of potential coverage, should be aware that no such surrender or disclaimer is intended or exists in this application. Limitations such as arose in *Hakim v. Cannon Avent Group, PLC*, 479 F.3d 1313 (Fed. Cir 2007), or the like are expressly not intended in this or any subsequent matter related.

Conclusion

The Assignee believes all concerns raised in the office action have been addressed as best understood and respectfully requests reconsideration and withdrawal of the concerns to the application. Allowance of the claims is requested at the Office's earliest convenience. Should there be any outstanding questions remaining, the Examiner is invited to contact the undersigned.

Dated this 10th day of July, 2008.

Respectfully Submitted,
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